

THIS DISPOSITION IS
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Mailed:
10 June 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Miguel Torres, S.A.
v.
Bodegas Muga S.A.

Opposition No. 91112586
to application Serial No. 75458417
filed March 27, 1997

Cynthia Clarke Weber of Sughrue Mion, PLLC for Miguel
Torres, S.A.

Michael A. Grow of Arent Fox PLLC for Bodegas Muga S.A.

Before Seeherman, Walters, and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

Bodegas Muga S.A. (applicant) applied (Serial No.
75458417) to register the mark shown below on the Principal
Register for "wines" in International Class 33.



The application indicates that the mark is translated as "tower landmark." The application also claims a date of first use in commerce between the United States and Spain at least as early as May 19, 1997. The application claims ownership of Registration No. 1,933,103 for the mark MUGA for wines.

Miguel Torres, S.A. (opposer) has opposed the registration of applicant's TORRE MUGA and design mark, alleging that it is the owner of numerous trademarks for the word TORRES and that there is a likelihood of confusion, mistake, or deception between its marks and applicant's mark when used on the goods. Opposer submitted status and title copies of the following registrations:

1. No. 897,048, issued August 18, 1970, for the mark TORRES (typed) for wines and brandy in Class 33. "Torres" is translated as "towers." Section 8 and 15 affidavits accepted/acknowledged. Second renewal.
2. No. 1,358,370, issued September 3, 1985, for the mark MIGUEL TORRES (typed) for brandy in Class 33. Section 8 and 15 affidavits accepted/acknowledged.
3. No. 1,358,371, issued September 3, 1985, for the mark shown below for liqueur in Class 33.

The mark is translated as "grand or great towers." Section 8 and 15 affidavits accepted/acknowledged.



4. No. 1,413,565, issued October 14, 1986, for the mark shown below for brandy and wine in Class 33. The word "Torres" is translated as "Towers." Section 8 and 15 affidavits accepted/acknowledged.

TORRES



5. No. 1,459,458, issued September 29, 1987, for the mark shown below for brandy in Class 33. The words are translated as "Three Towers." Section 8 and 15 affidavits accepted/acknowledged.

Tres Torres

6. No. 1,639,237 issued March 26, 1991, for the mark MIGUEL TORRES (typed) for wines in Class 33. Section 8 and 15 affidavits accepted/acknowledged. Renewed.
7. No. 2,265,107, issued July 27, 1999, for the mark TRES TORRES (typed) for brandy in Class 33. The mark is translated as "Three Towers."
8. No. 2,267,399 issued August 3, 1999, for the mark GRAN TORRES (typed) for liqueurs in Class 33. The mark is translated as "Great Towers." Section 8 and 15 affidavits accepted/acknowledged.
9. No. 2,269,173, issued August 10, 1999, for the mark LAS TORRES (typed) for wines in Class 33. The mark is translated as "The Towers."

Applicant denied the salient allegations of the notice of opposition.

The Record

The record consists of the following items: the file of the involved application; the trial testimony deposition

of opposer's distributor, Greg Christoff, with accompanying exhibits; the trial testimony deposition on written questions of applicant's United States agent, Jorge Ordonez, with accompanying exhibits; the trial testimony deposition on written questions of applicant's commercial manager, Manuel Muga Pena, with accompanying exhibits; the stipulated testimony of Kathryn Taylor authenticating numerous exhibits consisting of menus and Internet printouts; opposer's notice of reliance on copies of TTAB papers and electronic printouts of trademark records and on status and title copies of its registrations; and applicant's notice of reliance containing dictionary definitions, entries from telephone books and publications, and printouts from USPTO and other United States government agencies.¹

Background

Both applicant and opposer are Spanish wineries that have been exporting their wines to the United States for a number of years. Applicant first sold TORRE MUGA wine in the United States in 1997. Ordonez dep. at 6. Opposer's use is significantly earlier. Christoff dep. at 9-10. Both parties' wines have received favorable attention in publications and both parties have won awards for their wines. See Christoff dep. Ex. 12 (Torres - *Wine Spectator*

¹ Opposer has moved to strike portions of applicant's notice of reliance. We have not considered that evidence.

"Most Important Winery in Spain" award); Ex. 1 (*Wine Spectator* - "Spain's finest Cabernet Sauvignon"); Ex. 8 at 16 (*Wine Enthusiast* "Spanish Wines: A Red Star Burns Bright" - Torres) and Muga Ex 1. (*Wine Spectator* - "Thomas Matthews' Top Scoring Wines from Spain" - Rioja Torre Muga and Torres Penedes Grans Muralles), *Wine Spectator* - "Top Picks of the New Releases - Rioja Torre Muga Reserve) *Wines & Spirits* - "Best Wines of 2000" - Rioja Torre Muga).

Priority

Priority is not an issue here to the extent that opposer relies on its ownership of nine federal registrations for wine, brandy, or liqueur that include the word TORRES. See King Candy Co. v. Eunice King's Kitchen, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Applicant does not dispute opposer's priority.

Likelihood of Confusion

As with any likelihood of confusion case, we analyze the facts under the principles set forth by the Court of Customs and Patent Appeals, one of the predecessor courts of the Court of Appeals for the Federal Circuit, in In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). See also In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003); Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

The thirteen du Pont factors are:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
- (4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.
- (5) The fame of the prior mark (sales, advertising, length of use).
- (6) The number and nature of similar marks in use on similar goods.
- (7) The nature and extent of any actual confusion.
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
- (9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).
- (10) The market interface between applicant and the owner of a prior mark (e.g., a consent agreement).
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.
- (12) The extent of potential confusion, i.e., whether de minimis or substantial.
- (13) Any other established fact probative of the effect of use.

In this case, many of the factors are relevant so we will discuss them all, at least in passing.

We begin our analysis by discussing the second factor, the similarity or dissimilarity of the goods. In this case, applicant's goods are wines. Opposer's registrations ('048, '565, '237 and '173) are for wine also.² Therefore, the goods are legally identical. We must compare the goods as they are described in the application and the registrations to determine if there is a likelihood of confusion. Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed"). See also Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods" or services). The Federal

² Inasmuch as the goods in these registrations include wine and the marks are TORRES, TORRES and design, MIGUEL TORRES, and LAS TORRES, we will not separately consider the other registrations involving brandy and liqueur. If applicant's mark is not confusingly similar to the four wine registrations, it would not be confusingly similar to the other registrations. Conversely, if applicant's mark is confusingly similar to the four wine registrations, there is no point in separately considering the remaining registrations.

Circuit has held that when "marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992). Therefore, this factor favors opposer.

Also, because applicant's and opposer's goods are identical, we do not consider that there are any legally relevant differences in the channels of trade. Octocom Systems, 16 USPQ2d at 1787. See also Schieffelin & Co. v. Molson Companies Ltd., 9 USPQ2d 2069, 2073 (TTAB 1989) ("[M]oreover, since there are no restrictions with respect to channels of trade in either applicant's application or opposer's registrations, we must assume that the respective products travel in all normal channels of trade for those alcoholic beverages"). Applicant's arguments about potential differences in the price of the wines and where the wines are sold are not legally relevant to the extent that both applicant and opposer identify their goods as wine without any limitation; therefore, we must assume that these goods can be sold in any normal channel of trade without limitation as to price or quality. See In re Opus One Inc., 60 USPQ2d 1812, 1817 (TTAB 2001) (Applicant's "evidence concerning the expensive nature of applicant's restaurant services and of registrant's wine, as well as the Trademark

Examining Attorney's concession that applicant's and registrant's goods and services are expensive are legally irrelevant"). Therefore, factor three favors opposer.

Regarding the fourth factor, the conditions of sale and sophistication of purchasers, we again are constrained to hold that the differences are not legally significant because the goods are identified simply as "wine" and there is no basis to hold that purchasers of wine are sophisticated purchasers in general. Opus One, 60 USPQ2d at 1817 (Applicant's "arguments regarding the high cost of its actual restaurant services and of registrant's actual wine, and the resulting carefulness and sophistication of the purchasers, miss the mark," citing See In re Bercut-Vandervoort & Co., 229 USPQ2d 763 (TTAB 1986) ("rejecting the applicant's arguments regarding the high cost and quality of its wine and the sophistication of its purchasers, where application identified goods merely as 'wine'")).

There are several factors that are either not relevant or they do not have much impact on the analysis in this case. Factor 9 is not very relevant to the extent that both parties' basic product is wine and opposer's other products, e.g., brandy and liqueur, are also alcoholic beverages. Factor 10, 11, 12, and 13 (market interface, opposer's right to exclude, potential confusion, and other facts) are not

particularly significant except to the extent they are included within our discussion of the other factors.

We now turn to the other remaining factors that are central to the issue of whether there is a likelihood of confusion, i.e., the marks, fame, the number of similar marks in use, actual confusion, and the conditions of current use. We begin this stage of our analysis by comparing the marks for similarities and dissimilarities. Applicant's mark consists of the words TORRE MUGA with a tower design. All of opposer's marks contain the word TORRES. Registration No. '048 is for the typed word TORRES alone, No. '565 is for the word TORRES with a three-tower design, No. '237 is for MIGUEL TORRES in typed form, and No. '173 is for the typed mark LAS TORRES.

When we consider the marks, we look to see whether the marks are similar in sound, appearance, meaning, and commercial impression. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In addition, it is well settled that it is improper to dissect a mark and that marks must be viewed in their entirety.

Applicant's mark and opposer's marks are similar in sound and appearance to the extent that applicant's mark contains the word TORRE and opposer's marks consist of or contain the word TORRES. Further, both applicant's mark and

opposer's TORRES mark in Registration No. 1,413,565 include tower designs although the designs themselves are different.

Regarding the meaning of the term Torre(s), the application, registrations, and dictionary definition agree that the term is the singular and plural Spanish word for "tower." However, the term Torres is also a family name for individuals associated with opposer. Christoff dep. at 20-21 (Miguel Torres "or someone in his family come at least twice a year" to promote their wines). In addition, applicant has submitted evidence that the term "Torres" is a common surname in the United States. See Notice of Reliance Ex. 4, Manhattan White Pages (more than 700 listings); Ex. 6, Northern Virginia White Pages (more than 300 entries). MUGA, the other term in applicant's mark, is the family name of applicant's founders and officials (Manuel Muga Pena, Isaac Muga Martinez, and Isaac Muga Cano). Muga dep. at unnumbered p. 1; Opposer's Br. at 12 ("MUGA is a family name, with no meaning in the record"). As a foreign word, we consider the foreign meaning of Torre(s). In re Lar Mor International, Inc., 221 USPQ 180, 181 (TTAB 1983) ("It seems to us that the fact that both marks may be comprised of foreign words should not mean that we can disregard their meanings"). However, it is also clear that for many prospective purchasers of opposer's identified goods, the word "Torres" is likely to be viewed as a surname. Indeed,

the surname connotation is reinforced by the name of opposer "Miguel Torres, S.A."

On the other hand, applicant's mark MUGA is likely to be perceived as the surname it is because it has no other meaning, and Torre is likely to be perceived, at least by Spanish speakers, as the Spanish word for "tower." Since applicant's mark consists of the words "Torre" and "Muga," it is likely to be understood by Spanish-speaking prospective purchasers to refer to the "Muga tower."

Although opposer's marks may be understood as referring to Torres as a family name, as well as the plural of tower, either way, the connotation of opposer's marks is not the same as the connotation of applicant's mark. Similarly, the commercial impressions of the parties' marks are different. When we compare the marks in their entirety, as we are required to do, despite the similarities in the mark, there are significant differences as well. Thus, this factor is not dispositive. In re Coors Brewing Co., 343 F.3d 1340, 68 USPQ2d 1059, 1062 (Fed. Cir. 2003) ("Although we uphold the Board's finding that the two marks are generally similar, principally because they both use the term 'Blue Moon,' we note that similarity is not a binary factor but is a matter of degree").

The next factor we consider is the fame of opposer's mark. A "mark with extensive public recognition and renown

deserves and receives more legal protection than an obscure or weak mark." Kenner Parker Toys v. Rose Art Industries, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

"Famous marks enjoy wide latitude of legal protection since they are more likely to be remembered and associated in the public mind than weaker marks, and are thus more attractive as targets for would-be copyists." Palm Bay Imports, 73 USPQ2d at 1693.

Opposer makes the following arguments (Brief at 15-16) concerning the fame of its marks (citation to the record omitted):

Opposer was one of the early branded wine imports to the United States and Opposer's wine has been sold in the United States for decades. Over the years, Opposer has won numerous awards for its wines and has received very favorable wine reviews. In fact, Opposer has twice been awarded the "Critic's Choice Award" from the *Wine Spectator*. Opposer's TORRES branded wines have also won *The Wine Spectator* readers' poll for the most important and influential winery in Spain. There is no question that the TORRES Marks are famous and entitled to a broad scope of protection.

The fame of Opposer's Torres Marks is also evidenced by Opposer's policing efforts. Opposer has successfully opposed and objected to many applications which included the term TORRE, TORRI or TORRES. The fame of Opposer's TORRES Marks is unquestionable.³

³ Opposer also refers to two board cases involving opposer and different defendants in which fame was an issue and it was apparently resolved in opposer's favor. We note that opposer is required to prove the fame of its marks in this proceeding. We will not take judicial notice of opposer's fame. Certainly, applicant in this case is not bound by the actions of defendants in the previous cases, one of whom apparently did not contest the issue. Also, in the two cases that opposer cites, one, Miguel Torres, S.A. v. Casa Vinicola Gerardo Cesari S.R.I., 49 USPQ2d 2018 (TTAB 1998), was vacated by the Federal Circuit on appeal in a non-precedential opinion. 230 F.3d 1372 (Fed. Cir. 1999)

We begin our discussion of the opposer's evidence of its public recognition and renown by observing that the evidence to which opposer refers is hardly overwhelming. In its argument, opposer has not pointed to any evidence of sales and advertising expenses. During the cross-examination of opposer's witness, applicant's counsel questioned the witness about annual sales. The parties stipulated that the number was confidential. Christoff dep. at 41. In view of the parties' agreement, we will not identify the number. But it is not, by itself, indicative of fame. Furthermore, there is no context for considering opposer's sales, which limits its value in demonstrating fame. There is also little direct evidence of public recognition of opposer's marks besides its awards. The mere fact that a wine has been favorably reviewed or otherwise discussed in a wine industry publication is not particularly persuasive of a mark's public recognition inasmuch as the evidence suggests that these awards are not uncommon. See *Wines & Spirits*, Winter 2000 (100 Best Wines, 100 Best Buys,

(vacated and remanded). Subsequent proceedings at the TTAB and Federal Circuit are not reported. The other case is also an unpublished decision. "Decisions which are not so designated, or which are designated for publication only in digest form, are not citable authority. A nonprecedential or digest decision will, however, be considered in determining issues of claim preclusion, issue preclusion, judicial estoppel, law of the case, or the like, provided that (1) a party to the pending Board proceeding, or its privy, was also a party to the prior proceeding, and (2) a complete copy of the decision is submitted." TBMP § 101.03 (2d ed. rev. 2004).

70 Wineries of the Year); *Wine Spectator*, November 30, 1998 (27 Spanish Wines Rate 90+).⁴ Therefore, while we have considered the articles that opposer has submitted with Christoff Exhibits 8, 9, and 10 as evidence that opposer's marks have acquired some recognition, we cannot agree with opposer's characterization of its marks as being unquestionably famous, and this factor does not weigh heavily in opposer's favor.

We now approach one of the more unusual aspects of this case. Applicant argues (Brief at 11) that the opposition should be dismissed because "TORRES is a very weak mark entitled to a narrow scope of protection due to extensive third party use and registrations." Normally, this type of evidence is easily dismissed because there is no evidence of use or the evidence of use is limited. Carl Karcher Enterprises Inc. v. Stars Restaurants Corp., 35 USPQ2d 1125, 1131 (TTAB 1995) ("[T]he pictures of these restaurants tend to indicate that the operations are small and local in nature"). In this case, applicant also has submitted extensive evidence concerning third parties' use and registration of similar marks. Applicant's evidence is quantitatively and qualitatively different from what is normally encountered in likelihood of confusion cases.

⁴ Interestingly, applicant points out that it has received similar awards and recognition.

Applicant's evidence of third-party use begins with dictionary definitions. Applicant's definitions demonstrate that the English word "Tower" is translated as "Torre" in Spanish, Italian, and Portuguese. Notice of Reliance, Exhibits 2, 3, and 4.⁵ Applicant then submitted numerous documents showing third parties using the term. The first type of evidence consists of menus from various restaurants listing wines with TORRE in their names. Some examples follow⁶:

1. Allegrini "Palazzo Della **Torre**" Valpolicella (Italy)
Restaurant Agostino, Chicago, IL (Ex. 3)
San Benito House, Half Moon Bay, CA (Ex. 8)
Sonoma-Meritage Restaurant, Sonoma, CA (Ex. 11)
Spghettini Italian Grill, Seal Beach, CA (Ex. 12)
Sieno Ristorante, Austin, TX (Ex. 14)
Scutra, Arlington, MA (Ex. 15)
Chez Panisse, Berkeley, CA (Ex. 18)
Vuli Italian Restaurant, Stamford, CT (Ex. 23)
Viva Barcelona Restaurant, Westlake, OH (Ex. 28)
Wine Cellar, Coeur d'Alene, ID (Ex. 31)
Marche Aux Fleurs, Ross, CA (Ex. 34)
Last Resort Grill, Athens, GA (Ex. 37)
Kalamatas Cuisine, Fort Worth, TX (Ex. 38)
Santi Restaurant, Geyserville, CA (Ex. 40)
Francesca Restaurant, Chicago, IL (Ex. 41)
Antonio's Restaurant, Maitland, FL (Ex. 45)
Savoy Cucina, Asheville, NC (Ex. 46)
Pellogrino's Restaurant, New York, NY (Ex. 47)

⁵ Applicant also submitted that the word "Tower" is translated as "Tour" in French. Because "Tour" is also a readily recognizable English word and it is not similar to the term "Torre," we decline to consider this term as evidence that the term "Torres" is weak.

⁶ The first line lists the name of the wine and the next lines are the restaurants where the wine is on the menu. Sometimes, when the wine names are similar, but not exact, they are listed together. The exhibit number refers to the exhibit in the parties' stipulated evidence.

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2. Rosso di Montalcino La **Torre** Toscano
Amelia's Trattoria, Cambridge, MA (Ex. 4)
3. **Torre** Montepulciano D'Abruzzi
Nini's Italiano Restaurant, Easthampton, MA (Ex. 5)
4. Dolcetto Dogliani **Torre** San Martino
Da Giorgio Ristorante, Holmes Beach [CA] (Ex. 7)
5. Barbaresco "**Torre**," Produttori del Barbaresco
Gigino Restaurant, New York, NY (Ex. 9)
Bella Ciao Restaurant, Ann Arbor, MI (Ex. 17)
Signature Room, Chicago, IL (Ex. 26)
Cucina D'Angelo Ristorante, Boca Raton, FL (Ex. 27)
City Grill, Atlanta, GA (Ex. 79)
6. Due **Torre**, Cesari, Briuli, Italy
Four Columns Inn, Newfane, VT (Ex. 10)
7. Pinot Grigio - **Torre** Rosazza
Come On In Restaurant, La Jolla [CA] (Ex. 13)
Cascina Downtown, New York, NY (Ex. 42)
Grist Mill Restaurant, Farmington, CT (Ex. 49)
8. **Torre** Sveva "Castel De Monte"
Sieno Ristorante, Austin, TX (Ex. 14)
8. Merlot, **Torre** di Luna, Tretino-Alto Adige
Canaletto, Las Vegas, NV (Ex. 16)
Trattoria Del Lupo, Las Vegas, NV (Ex. 32)
Cascina Downtown, New York, NY (Ex. 42)
Bruschetta Ristorante, Fairfield, NJ (Ex. 43)
9. **Torre** Albeniz, Reserva
El Farol Restaurant, Santa Fe, NM (Ex. 19)
10. **Torremilanos** Gran Reserva
El Farol Restaurant, Santa Fe, NM (Ex. 19)
11. Morgadio Da **Torre** Alvarinho
Adega Grill, Newark, NJ (Ex. 20)
Aquario, West Harrison [NY] (Ex. 22)
LaSalette Restaurant, Sonoma, CA (Ex. 54)
12. **Torre** Oria Reserva
Sevilla Restaurant, San Diego, CA ((Ex. 25)
Ziziki's Restaurant, Dallas, TX (Ex. 33)
Habana Cuba, San Jose, CA (Ex. 58)
Gino's Restaurant, Baton Rouge, LA (Ex. 64)

Vincent's on Camelback, Phoenix, AZ (Ex. 88)

13. **Torre** Quarto Rosso, Puglia
Vista, Avon, CO (Ex. 35)
14. Pinot Grigio **Torre** Luna
Trattoria Dopo Teatro, New York, NY (Ex. 48)
Primavera Restaurant, Ft. Lauderdale, FL (Ex. 53)
2 Senza Ristorante, Red Bank, NJ ((Ex. 80)
15. **Torre** Vento Vigna Pedale
Armand's Restaurant, Chicago, IL (Ex. 57)
16. **Torre** di Giano
Ristorante Torre di Pisa, New York, NY (Ex. 60)
17. Antiche **Torre** Chianti
Mulino's Trattoria, Northampton, MA (Ex. 87)
18. **Torre** Orica Blanco
Don Pepe's Cuban Cafe, Altamonte Springs, FL (Ex. 84)
19. Brunello di Montalcino, La **Torre**
Max's Oyster Bar, West Hartford, CT (Ex. 85)
20. Chianti Classico Riserva, Paneretta, "**Torre** a
Destra," Toscana
Lugno Restaurant, Salt Lake City, UT (Ex. 86)

Applicant also submitted exhibits showing various bottles of wine that its representatives purchased at a Chantilly, Virginia, wine store. These exhibits include numerous bottles of TORRE SPINA (Exhibits 116-128), TORRE DE BARREDA (Exhibits 134 135), and TORREGIORGI (Exhibits 141-142). The record also includes websites indicating that online wine stores offer various wines with the term Torre. See, e.g., www.winespecialist.com, parkavenuewineshop.com, and www.drinksite.com (Allegrini Palazzo Della **Torre**); www.beer-wine-spirits.net (**Torre** Oria Reserve);

www.pjwine.com (**Torre** Quatro Rosso Puglio);

www.cellarswarehouse.com (**Torre** di Luna Merlot); and

www.winespecialist.com (Adegas Morgadio **Torre** Fornelos

Albarino). Some of these wines also show the word Torre or Torri⁷ used on wine along with a tower design. Exhibits 117-128, 139 and 140.

In addition, opposer's witness acknowledged that he was aware of wines known as Torre de Luna and Palazzo della Torre. Christoff dep. at 47-48. Applicant's witness identified the following wines as originating from countries other than Spain that are sold or offered for sale in the United States: Torresella Paterno, Torre di Luna, Torre Grande, Torre Rosazza, Torre Sesta, Torre Sveva, Torre Terza, and Torrevecchia. Ordonez dep. at 16.

The above examples from restaurants and wine stores showing that third parties use the word "Torre" on wine that is sold in restaurants and stores throughout the United States certainly support applicant's argument that the term "Torre" would not be exclusively associated with wines from opposer. "Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection."

⁷ "Torri" apparently also means "towers." See Miguel Torres S.A., 49 USPQ2d at 2020. Opposer has identified "Torri" as a term that it considers to create likelihood of confusion issues. Opposer's Brief at 16.

Palm Bay Imports, 73 USPQ2d at 1693. See also In re Broadway Chicken, Inc., 38 USPQ2d 1559, 1565-66 (TTAB 1996). ("Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field"); In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818, 819 (Fed. Cir. 1986) ("The record shows that a large number of marks embodying the words 'bed and breakfast' are used for similar reservation services, a factor that weighs in favor of the conclusion that BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL are not rendered confusingly similar merely because they share the words 'bed and breakfast'"). We note that *Wine Spectator's Ultimate Guide to Buying Wines* (6th Ed. 1998) lists numerous wines from wineries such as Torre, LA; Torre Di Luna; Torre Rosazza; Torre Terza; Torregiorgi; Torresella; and Torre de Ona. Applicant's Notice of Reliance, Ex. 13. The wines from these wineries were all reviewed by *Wine Spectator*, which opposer's witness described as "the most influential magazine in the wine business." Christoff dep. at 43.

Opposer has referred to its policing efforts on behalf of its trademarks. See Opposer's Brief at 16 and Opposer's Notice of Reliance, Exhibits 1-21. In response, applicant

has submitted copies of several registrations that show that third parties have registered various "Torre" marks for wine. See Registration No. 2,177,753 (TORRE DE GALL for sparkling wine); No. 2,655,606 (TORRE ORIA for wines and sparkling wines); No. 2,171,328 (PALAZZO DELLA TORRE for wines); and No. 2,407,900 (DUE TORRI and label for Italian dry red wine).

We find that the evidence of others' use of the term "Torre" in association with wine is substantial evidence that weighs in applicant's favor.

The final factors we address are actual confusion and the conditions of current use. Both parties agree that there is no evidence of actual confusion. Opposer's Br. at 17; Applicant's Br. at 29. Ordinarily, evidence of a lack of actual confusion is not particularly persuasive. The absence of actual confusion does not mean there is no likelihood of confusion. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983); J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991). However, in this case, there is evidence that applicant's and opposer's marks are encountered by the identical consumers at the identical time. See Stipulation Ex. 28 (TORRE MUGA and three TORRES wines on same wine list page); Ex. 30 (TORRE MUGA and TORRES GRAN CORONAS on same wine list page);

Ex. 59 (TORRE MUGA and TORRES CORONAS on same wine list); and Ex. 71 (TORRE MUGA and GRAN VINA SOL TORRES available at same restaurant). Applicant has also included a series of photographs (Stipulation, Exhibits 151-157) that show a display of wine in a Spanish restaurant in Washington, D.C., that includes TORREMILANOS, TORRES, and TORRE MUGA wines.

In this case, the parties had been marketing their wines in the United States since 1997. Their wines are sold in the same types of wine stores and restaurants. Indeed, there is some evidence that their wines are sold in the exact same restaurants. Also, the wines have been reviewed in the same publications and are listed in the *Wine Spectator's* Buying Guide. Under these circumstances, we cannot say that the factors of actual confusion and conditions of use are neutral. G.H. Mumm & Cie v. Desnoes & Geddes Ltd., 917 F.2d 1292, 16 USPQ2d 1635, 1638 (Fed. Cir. 1990) ("Further, we note that despite over a decade of the marketing by Desnoes of Red Stripe beer in certain of the United States, Mumm was unable to offer any evidence of actual confusion. This too weighs against a holding of a likelihood of confusion"). See also Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.3d 1036, 50 USPQ2d 1545, 1555-56 (9th Cir. 1999) ("We cannot think of more persuasive evidence that there is no likelihood of confusion between these marks than the fact

that they have been simultaneously used for five years without causing any consumers to be confused as to who makes what"); Oreck Corp. v. U.S. Floor Systems, Inc., 803 F.2d 166, 231 USPQ 634, 639 (5th Cir. 1986) ("Oreck's inability to point to a single incident of actual confusion [after seventeen months of concurrent use] is highly significant"). Therefore, we resolve these factors in applicant's favor.

We now balance the factors in this case. Certainly, the goods of the parties are identical to the extent that they include wine and opposer's other registrations include brandy and liqueurs. Because the goods are at least in part identical, the channels of trade and purchasers must also be considered to be the same. Both marks contain the same root word, TORRE(S). We have also considered that opposer has registrations for and uses several variations of its TORRES mark, including LAS TORRES, MIGUEL TORRES, and GRAN TORRES. However, the marks are not identical and applicant's mark includes a significantly different element, MUGA. We also find that the meaning and commercial impressions of the marks are different. With the multiple uses of the term TORRE by others, it is likely that prospective purchasers would not assume that all marks containing this element identify wine emanating from a single source. Instead, consumers are likely to look to the term "Muga" to distinguish applicant's wines. To many purchasers who are

unfamiliar with the Spanish, Italian, or Portuguese languages, the term Torre would be simply a word that commonly appears on imported wine and Muga would be the more distinctive term. As for those familiar with the translation of the term, because of the common use of the term Torre on wine, they would likely focus on the term Muga.

Applicant has submitted substantial evidence that third parties are using the term TORRE as part of the wines' names. Indeed, even a tower design is not unusual on wine labels. Finally, there has been no evidence of actual confusion despite the fact that the parties' wines are sold in the identical restaurants. When we balance these factors, we are left to conclude that there is at best a possibility of confusion and not a likelihood of confusion. Bongrain International (American) Corp. v. Delice de France, Inc., 811 F.2d 1479, 1 USPQ2d 1775, 1779 (Fed. Cir. 1987) (The "statute refers to likelihood, not the mere possibility, of confusion").

Conclusion

When we compare applicant's and opposer's marks in their entirety as used on the goods and consider all the other factors on the issue of likelihood of confusion, we are convinced that there is no likelihood of confusion in this case.

Opposition No. 91112586

DECISION: The opposition is dismissed.